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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,056	09/19/2006	Poh Soon Erh	S006.023.NPEUS	3628
56374	7590	12/15/2009	EXAMINER	
EAGLE IP LIMITED			WALCZAK, DAVID J	
13/F, Bright Way Tower				
33 Mong Kok Road			ART UNIT	PAPER NUMBER
Kowloon,				3751
HONG KONG				
NOTIFICATION DATE		DELIVERY MODE		
12/15/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eip@eip.hk

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/599,056	ERH, POH SOON	
	<b>Examiner</b>	<b>Art Unit</b>	
	David J. Walczak	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 October 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.  
 4a) Of the above claim(s) 11 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 and 12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 19 September 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Election***

Applicant's election without traverse of Group I (claims 1-10 and 12) in the reply filed on 10/20/09 is acknowledged.

### ***Abstract***

The abstract of the disclosure is objected to because phrases that can be implied, such as "is described" (see line 2) should not be present therein. Further, a properly filed abstract should be on a page with no other verbiage thereon. Correction is required. See MPEP § 608.01(b).

### ***Drawings***

The drawings are objected to because:

Since there is a "FIG. 3A" and a "FIG. 3B", the recitation "FIG. 3" should not be present on that drawing sheet. Further, on page 3 of the specification, there should be a brief description of both Figures 3A and 3B (as opposed to single brief description of Figure 3); and

Reference character 300 (see paragraph 0032) is not present in any of the drawings.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

As discussed above, there should be a brief description of both Figures 3A and 3B;

On line 5 of paragraph 0024, it appears that "smaller" should be --larger than the-- since end 130 is shown to be larger in cross-section than end 120;

On line 2 of paragraph 0036, "distal end 232" should be --distal end 230--;

On line 7 of paragraph 0037, "inlet 230" should be --inlet 232--; and

On line 8 of paragraph 0037, on lines 2 and 4 of paragraph 0038 and on line 2 of paragraph 0039, "retainer 292" should be --retainer 294--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 1-10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, it is unclear as to which element is permitted to rotate (see line 9, i.e., "to permit rotation" of what? It appears that the applicant should define that the applicator is permitted to rotate eccentrically with respect to the rolling guide due to the resilient means, see lines 6-9 of paragraph 0040).

In regard to claims 2 and 12, an antecedent basis for "the planar cross-section of the coupler end" and "the planar cross-section of the distal end" have not been defined. Further in regard to claim 12, it is unclear as to how the cross-sections of the coupler and distal ends can be the same if the applicator is frustoconically shaped (as defined in claim 1).

It is noted that the phrase "resilient means to permit rotation" is considered not to invoke 112 6th paragraph.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Wuelker.

In regard to claim 1, Wuelker discloses a roller applicator comprised of a frustoconically-shaped applicator having a coupler end (at 13), a distal end (at 22), an external surface 11 and a paint absorbable member 25, a circular integral guard (element 13) disposed at the coupler end and a “rolling guide” 22 disposed at the distal end wherein the rolling guide 22 coacts with a “resilient means” (the opening in elements 11 and 25 that is shown to contact portion 22 of stem 16) to permit rotation about an axis of rotation. It is noted that statements of intended use, i.e., “for applying paint” do not lend any patentable structure to the claims. Further, the Wuelker device is capable of applying paint.

In regard to claim 2, the planar cross-section of the coupler end is larger than the planar cross-section of the distal end.

In regard to claim 3, the applicator defines a chamber having perforations 27 therein.

In regard to claim 4, the chamber is accessible by a closable inlet 28.

In regard to claim 5, the coupler end has a coupler 17 fit to a handle 16.

In regard to claim 6, the coupler end permits rotation of the applicator about an axis.

In regard to claim 7, the diameter of the guard 13 is capable of performing as claimed (depending on how much force is applied to the member 25.

In regard to claim 8, the above defined resilient means is radially disposed about the axis of rotation o the applicator.

In regard to claim 9, the resilient means is held in place by a retainer 21, 26.

### ***Allowable Subject Matter***

Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Pratt reference is cited for disclosing another frusto-conical applicator.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huson Gregory can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
12/8/09

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